

REMARKS

The issues in the instant application are as follows:

- The Office Action has been improperly made final;
- Claims 1 – 25 are rejected under 35 U.S.C. § 103(a).

Applicant hereby traverses the outstanding rejection, and requests reconsideration and withdrawal in light of the amendments and remarks contained herein. Claims 1 – 3, 5 – 16, and 18 – 25 are pending in this application.

Improper Finality

The Finality of the Office Action dated October 9, 2003, is improper, and is hereby requested to be withdrawn. A second Action on the merits shall be made Final, EXCEPT where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor under certain conditions dealing with an IDS. *See* M.P.E.P. §706.07(a).

In Applicant's previous response, dated August 13, 2003, claims 1 and 8 were amended to include the limitations of original claims 4 and 17. Original claim 4 recited "The projector of claim 1 further comprising:" Claim 1, as amended in Applicant's previous response, added the following limitation from claim 4, "a flatbed scanner for providing scanned data to said projection system." Thus, claim 1 was amended to include the exact limitation from original claim 4.

In the previous Office Action, mailed on June 17, 2003 the Examiner rejected claims 4 and 17 under 35 U.S.C. § 102(e) as being anticipated by *Yasukawa*. After Applicant argued in its previous response that *Yasukawa* did not, in fact, teach the elements described in claims 4 and 17, and re-wrote those elements into their respective base claims, the Examiner issued a final office action with a new rejection under 35 U.S.C. § 103(a) using a new reference, *Lin*, to supply the amended elements of independent claims 1 and 8. By this action, the Examiner is improperly issuing a final office action using a new ground of rejection for an original claim. Redrafting a dependent claim into independent form does not create an amendment

which could precipitate grounds for a new rejection because the claim already existed in the original form of the application.

Applicant additionally amended claim 1 to include the limitation of “portable” in the preamble. However, this amendment could not form the basis of a new rejection because, as stated by the Examiner in the Remarks section, “As for the limitation of ‘portable’ in the preamble, the examiner asserts that it carries no patentable weight to the amended claim 1.” Remarks, p. 12. The Examiner admitted that this additional amendment carried no patentable weight that could support making a new rejection. As such, Applicant respectfully submits that the amendments made in the previous response did not precipitate the Examiner’s new grounds of rejection and, thus, the finality of the Office Action mailed on October 9, 2003 is improper. Applicant, therefore, requests the Examiner to withdraw the finality of the pending Office Action.

Claim Rejections Under 35 U.S.C. § 103(a)

In his response to Applicant’s previous remarks, the Examiner states that *Yasukawa* teaches all the limitations of the amended claim 1 except the additional limitation of “a flatbed scanner for providing scanned data to said projection system.” However, the Examiner has failed to show, other than by mere statement, that either *Yasukawa* or *Lin* discloses projecting from a single apparatus and acquiring presentation data from an optical scanner within the same single apparatus, as claimed in independent claim 8.

As Applicant stated in his previous response, *Yasukawa* is a network projector “structured by servers, a projector, and a network which connects to the servers and the projector.” Abstract. However, the teachings of *Yasukawa* are clear that it has a projector connected into a network which does not define projecting or acquiring presentation data from an optical scanner within the single apparatus. *Yasukawa* is a conglomeration of several separate components spread across a large network. The Examiner attempts to provide, at least, a flat bed scanner through recitation of *Lin*. However, *Lin* also only teaches a scanner as a separate portion of the described invention. Col. 3, ln 35 – Col. 4, ln 31; FIGURES 1A, 1B, and 1C. Therefore, even with the combination of *Yasukawa* with *Lin*, the Examiner cannot show each and every element of claim 8.

Claim 1 was amended to further clarify its previous amendment, which noted that claimed projector is a portable projector. Claim 1 was amended to require the projection system and the flatbed scanner to each be within the single container, as shown in FIGURE 1 and described, at least, at pages 8 and 10. Furthermore, claim 22 was similarly amended to further clarify the previous amendment to require the means for projecting and the means for receiving presentation data from a scanning apparatus to both be at the portable system. Support for these amendments is found in FIGURE 1 and, at least, at pages 8 and 10. No new matter was added. Because claims 1 and 22 share similar elements to claim 8 that address the projection system being contained in a single container, claims 1 and 22 are also patentable over the 35 U.S.C. § 103(a) rejections of record.

Claims 2, 3, 5 – 7, 9 – 16, 18 – 21, and 23 – 25 depend from base claims 1, 8, and 22, respectively, and thus inherit all limitations of those respective base claims. Thus, Applicant respectfully asserts that, for the above reason, claims 1 – 3, 5 – 16, and 18 – 25 are patentable over the 35 U.S.C. § 103(a) rejection of record and respectfully requests the Examiner to withdraw said rejections.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10004915-1 from which the undersigned is authorized to draw.


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Date of Deposit: December 8, 2003

Typed Name: John Pallivathukal

Signature: 

Respectfully submitted,

By 
Thomas J. Meaney
Attorney/Agent for Applicant(s)
Reg. No.: 41,990

Date: December 8, 2003

Telephone No. (214) 855-8230